

DOCKET NO.: MSFT-0180/138333.1
Application No.: 09/671,055
Office Action Dated: September 29, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

The foregoing Amendment and the following Remarks are submitted in response to the Final Office Action mailed September 29, 2003 (Paper No. 8) in connection with the above-identified application and are being filed within the three-month shortened statutory period set for a response by the Final Office Action.

Applicants respectfully request that the present Amendment After Final be entered since the Amendment adds no new matter to the Application, adds no new claims, raises no new issues, does not require further searching by the Examiner, addresses the issues raised by the Examiner, and places the Application in condition for allowance or in better form for an appeal. Applicants also respectfully submit that the present Amendment after Final is necessary to place the Application in condition for allowance, and was not earlier presented due to a failure on the part of the undersigned to appreciate the advisability of such Amendment until receipt of the Final Office Action.

Claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 are pending in the present application as amended. Claims 4, 26, and 48 have been canceled and the subject matter thereof has been incorporated into independent claims 1, 23, and 45, respectively, and claims 16-22, 38-44, and 60-66 have been canceled. All remaining claims stand rejected under the Final Office Action. Applicants respectfully request reconsideration and withdrawal of the rejections of the claims consistent with the following remarks.

The Examiner has again rejected the claims under 35 USC § 103(a) as being obvious over Stefik et al. (U.S. Patent No. 5,634,012) in view of Ginter et al. (U.S. Patent No. 5,892,900) and further in view of Biddle et al. (U.S. Patent Application Publication No.

2002/0107809). Applicants again respectfully traverse the § 103(a) rejection insofar as it maybe applied to the claims as amended.

Preliminarily, Applicants respectfully submit that the § 103(a) rejection is deficient for the reason that the Examiner has failed to specifically point out how the cited references disclose or suggest each element and limitation recited in the claims. In particular and with regard to independent claims 1, 23, and 45, the Examiner briefly sets forth a general appraisal of what each of the cited references discloses, and then admits that none of the three references specifically discloses all of the limitations of the claims. Nevertheless, the Examiner concludes without any more-specific analysis with regard to the elements and limitations of the claims that one skilled in the art would combine the overall teachings of the references to arrive at the limitations of such claims because such a combination would result in a desirable or attractive system.

Applicants note that the Examiner argues in the Final Office Action at page 2 that a requisite amount of such specificity has been set forth. However, Applicants respectfully disagree. In particular, Applicants respectfully submit especially with regard to independent claims 1, 23, and 45 that the Examiner merely cursorily describes the general thrust of each cited reference and, without much if any analysis of the elements and limitations of such claims and how such elements and limitations are disclosed by the cited references, concludes that such claims are obvious. Applicants do note that in setting forth an amalgamated claim 1/23/45 at page 4, the Examiner does provide a single citation to the Stefik reference with regard to the obtaining limitation, but also respectfully submit that such single citation sorely points out the lack of any other citations in connection with such amalgamated claim 1/23/45.

Applicants again respectfully submit that the Examiner's failure to point out the rationale for the rejection with more specificity, especially with regard to claims 11, 23, and 45, amounts to a blanket rejection of such claims that cannot satisfy the requirement that the Examiner make a *prima facie* case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such a blanket rejection of the claims without providing any specific details does not at all provide to Applicants any indication of why the cited references should or could be combined to produce the invention recited in such claims. Further, such a blanket rejection of the claims puts Applicants in the untenable position of having to respond to the rejection by guessing at the Examiner's specific rationale for such rejection, and consequently puts Applicants in the untenable position of having to guess how such a rejection might be overcome without unnecessarily creating file wrapper estoppel.

Applicants note that the Examiner asks in the Final Office Action at page 2 that Applicants consider fully the entire references, as if to suggest that the specific rationales for the rejection is somewhere in the entirety of such references. However, Applicants respectfully submit that it is the Examiner's responsibility to make a *prima facie* case for obviousness under Section 103, and not the Applicants' responsibility to somehow glean from the entirety of the cited references what the Examiner could or should intend.

That said, Applicants note that independent claim 1 recites a method for a retailer to facilitate issuance of a digital license from a licensor to a customer for a corresponding piece of digital content. In the method, the retailer receives from the customer payment for the license, where the payment is to be shared with the licensor in a pre-determined manner. The retailer obtains from the customer customer-based information and composes an actual license request, which includes the obtained customer-based information and retailer-based

information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor. The retailer then forwards to the licensor the actual license request.

In addition, Applicants note that claim 1 has been amended to include the subject matter of now-canceled claim 4, and thus now recites that the customer has a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license. To obtain the customer-based information, then, the retailer delivers to the customer a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer, and also delivers to the customer a controller that can control the DRM system of the customer. Such controller directs such DRM system to send a dummy license request for a license for the dummy package, where the dummy license request is directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package. The retailer then receives at the interposing site from the customer the dummy license request including customer-based information. Accordingly, composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information. Independent claim 23 as amended recites similar subject matter to that of claim 1 as amended, although in terms of a computer, and independent claim 45 as amended also recites similar subject matter to that of claim 1 as amended, although in terms of a computer-readable medium.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such

repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik system, and both the work and its attached license are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a license separate from a digital work.

The Ginter reference discloses a system for electronic commerce where content is securely transmitted and rendered in a rights-enforced manner. Generally, in the Ginter reference, secure subsystems of computers or the like provide a distributed virtual distribution environment (VDE) that enforce a secure chain of handling and control of protected digital content. Thus, the Ginter reference discloses employing such a VDE to store, disseminate, and protect content while still ensuring that such content is in secure, protected environments established at each node within the VDE.

The Biddle reference discloses a system for managing licensing data where a distributor 25 and a vendor 40 work together to distribute software to a user 30. However, Applicants after having reviewed the disclosure of the Biddle reference can find no disclosure or suggestion that the Biddle reference has incumbent therein a retailer that receives from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by the claims of the present application.

Moreover, after reviewing each of the aforementioned, Stefik, Ginter, and Biddle references, Applicants can find no disclosure in any of such references that in connection

with a retailer providing a license to a customer, the retailer delivers to the customer a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer, and also delivers to the customer a controller that can control the DRM system of the customer, as is required by claims 1, 23, and 45; that such controller directs such DRM system to send a dummy license request for a license for the dummy package, where the dummy license request is directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package, as is also required by claims 1, 23, and 45, and that the retailer then receives at the interposing site from the customer the dummy license request including customer-based information, as is further required by claims 1, 23, and 45. Thus, such Stefik, Ginter, and Biddle references also do not disclose that composing an actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information, as is additionally required by claims 1, 23, and 45.

Moreover, after reviewing each of the aforementioned, Stefik, Ginter, and Biddle references, Applicants can find no suggestion or teaching in any of such references that would provoke one skilled in the art to combine the entirety of the teachings of such references to result in the present invention as recited in such claims 1, 23, and 24. Applicants respectfully invite the Examiner to specifically point out such disclosures, suggestions or teachings should the Examiner disagree.

Applicants note with respect to now-canceled claims 4, 26, and 48 in the Final Office Action at pages 6 and 7 thereof that none of the cited references disclose utilizing a dummy package in the manner recited in the claims. Nevertheless, the Examiner argues that it would

be 'inherent that a system configured as per the teaching of [the cited references] would have the means to' so utilize the dummy package.

Insofar as such 'inherency' argument applies to claims 1, 23, and 45, Applicants respectfully point out that it is not enough that a system could be configured to achieve a particular result. Instead, the Examiner must point to a specific teaching or suggestion in the cited references that would in fact provoke one skilled in the art to so configure the system. The Examiner has failed to do so.

Moreover, insofar as such 'inherency' argument applies to claims 1, 23, and 45, Applicants also respectfully direct the Examiner's attention to MPEP § 2112. In particular, at such section, the MPEP discusses that the issue of inherency was recently addressed by the U.S. Court of Appeals for the Federal Circuit in *In re Robertson*, 49 U.S.P.Q.2D (BNA) 1949 (Fed. Cir. 2/25/1999) (Appealed from Patent and Trademark Office Board of Patent Appeals and Interferences). As noted in *Robertson*, anticipation under § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency under Section 102, though, extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at

1749. According to Robertson, then, a finding of anticipation by inherency requires an attempt based on extrinsic evidence to show that the missing elements are "necessarily" disclosed, and that an artisan of ordinary skill would so recognize. Inherency is not established by what could, should, or might happen or occur or be present.

According to Robertson, then, inherency is to be found only in connection with a rejection under Section 102, and not under Section 103. For this reason alone, such inherency argument should be withdrawn in connection with the present Section 103 rejection.

Moreover, and at any rate, in setting forth the inherency argument and in arguing same, the Examiner cited no such extrinsic evidence, and made no attempt based on any such extrinsic evidence to show that it would be 'inherent that a system configured as per the teaching of [the cited references] would have the means to' so utilize the dummy package. Also, the Examiner made no attempt based on any such extrinsic evidence to show that an artisan of ordinary skill would recognize any such necessities.

As a result, Applicants respectfully submit that the Examiner has not made a proper finding of inherency that would support the present § 103 rejection.

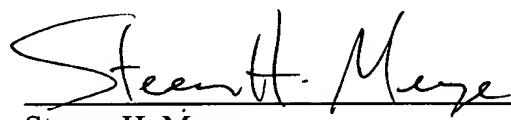
Accordingly, Applicants respectfully submit that none of the Stefik, Ginter, and Biddle references discloses or suggests the invention recited in claims 1, 23, and 45, or any claims depending therefrom. For all of the aforementioned reasons, then, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

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In view of the foregoing discussion, Applicants respectfully submit that the present application including claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 is in condition for allowance, and such action is respectfully requested.

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